

REMARKS

Following entry of this amendment, claims 35-49 will be pending in this application. Claims 1-13 are canceled herein without prejudice.

35 USC § 112, second paragraph

Claims 1-13 and 35-49 were newly rejected as allegedly indefinite. As the basis for this rejection, the Office action alleges that the metes and bounds of the term “gene” in claim 2 are ambiguous (page 2), but then for reasons that are unclear extends the same ground of rejection to each of the remaining claims (claims 1, 3-13, and 35-49). The action states only that these claims “are generic to claim 2 and encompass the term gene” (page 3). Applicants point out that none of claims 1, 3-13 and 35-49 recites the term “gene” nor even depends from a claim that recites the term “gene.” While it is true that “Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim” (37 CFR § 1.75(c)), the inverse is not true, and the term “gene” is thus not present in any of claims 1, 3-13, and 35-49. Therefore, the rejection of claims 1, 3-13, and 35-49 as somehow “encompassing” the disputed term “gene” is improper.

Applicants disagree with the rejection of claims 1-13, but have canceled these claims without prejudice, solely to further prosecution. Claims 35-49 do not depend from claim 2 or otherwise include the term “gene.” Therefore, applicants request reconsideration and withdrawal of the rejection of claims 35-49 as allegedly indefinite.

Finality

Applicants request that the Examiner withdraw the finality of the instant Office action. The Office action asserts that “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action” (page 3). However, this is not the case. The rejection is based entirely on the alleged indefiniteness of a word that is present in one and only one claim (claim 2) and that was present in claim 2 as originally filed. The amendments to which the Examiner apparently refers were filed on June 12 and 23, 2008. None of these amendments

included the disputed term “gene.” Because the term “gene” was present originally in claim 2 and not added by any of applicants’ amendments, it cannot be said that the amendments “necessitated the new ground of rejection.” The finality of the rejection was therefore premature. Applicants request withdrawal of the finality of the instant Office action.

CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance, which action is expeditiously requested.

This reply is being submitted with a Petition for Extension of Time and the required fee. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 14875-0135US1.

Respectfully submitted,

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